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IN THE

Supreme Court of the United States

OCTOBER TERM 1968

No. 299

ERWIN-NEWMAN COMPANY,

Petitioner,

—v.—

THE UNITED STATES.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

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July 17, 1968.

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Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Claims entered on April 19, 1968 in the above entitled case.

Opinions and Order Below

The opinion of the United States Court of Claims, which is printed in Appendix B hereto, *infra*, at pages 5a-22a adopts in its entirety and contains as an integral part thereof the opinion of Commissioner Lane filed herein on September 21, 1967 and is reported at 393 F. 2d 819.

Jurisdiction

The opinion of the United States Court of Claims was filed on April 19, 1968. The jurisdiction of this Court is

invoked under 28 U. S. C. §1255(1)—see page 4a, Appendix A.

The jurisdiction of the Court of Claims is established by 28 U. S. C. §1498, see page 1a, Appendix A.

Questions Presented

1. Whether the standards for determining the "non-obviousness" of patented inventions, as newly announced by this Court in *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966) and as further explained in *United States* v. *Adams*, 383 U. S. 39 (1966), require or permit a court to deny patentability to a novel invention on the theory that, although many very skilled engineers had tried, come close and yet never hit the invention target, the level of structural engineering skill was sufficient that the invention *should have been obvious* to an ordinarily skilled man and, therefore, in spite of the factual contradiction, the invention *must have been* obvious under 35 U. S. C. §103? This statement of the transcendency assigned to "hindsight" should alone demonstrate the need for this Court authoritatively to clarify the rule of the *John Deere* and *Adams* cases and to restore stability to our patent procedure.

2. Whether the rule of obviousness as applied by this Court in *United States* v. *Adams, supra,* is limited to situations in which the novel feature has previously been regarded as unworkable and is not applicable to situations where, once the novelty is conceived of, its workability and usefulness are accepted and its advantages immediately recognized? Otherwise the cases are identical.

3. Whether a cantilevered structural roof design, specified in an issued and admittedly novel patent (U. S. Patent No. 2687102, hereinafter called the '102 patent) under 35 U. S. C. §102, may, nevertheless, be held invalid as obvious under 35 U. S. C. §103 by assuming that structural engineers would refer to an obscure and debatable claim in a 20 year old airplane (U. S. Patent No. 1892902) or to an older (40 years) bascule bridge patent (U. S. Patent No. 974358) and would have gleaned therefrom the concept of the '102 invention (although not inherent in either older patent) in face of uncontradicted evidence that no one prior to plaintiff's assignors had ever thought of the '102 invention concept and that many experts in the structural art had tried to solve the problem, but had not done so?

Statutes Involved

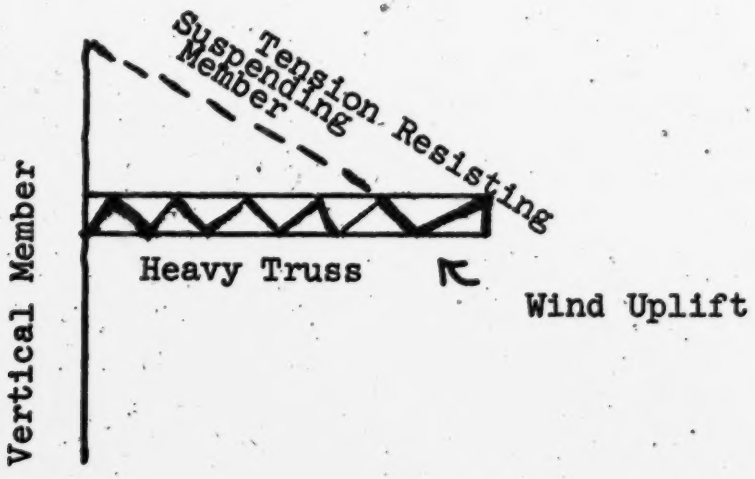
The pertinent statutes involved have been officially enacted as 28 U. S. C. §1498(a), 35 U. S. C. §102 and 35 U. S. C. §103 and are set forth in Appendix A hereto, *infra,* at pages 1a, 2a and 3a.

Statement

This suit for infringement is based on a duly issued patent, admittedly novel, which covers the design for a cantilevered structure suitable especially for airplane hangar construction.

Cantilevered structures are ages old. Until the '102 invention, they involved a horizantal truss or beam extending from an upright pole or vertical member and held

down against wind uplift by the force of gravity on the dead weight of the horizontal member and, when necessary, prevented from pitching forward by a slender slanting suspending member (from the vertical member to the truss) which resisted only the downward pull of the heavy truss (F. 13).* The basic ingredient of the concept prior to the '102 invention was that the dead weight of the truss, i.e., the pull of gravity, resisted wind uplift—the slanting suspending member was used only in tension to prevent a forward pitch. A line drawing of the structure—using a dotted line to show the resistance of tension—looked like this:



The novel concept of the '102 invention (F. 12) was simple and yet a radical change from customary engineering design. Admittedly, it had never been conceived of before in structural engineering (F. 13). Drawn as above, it may be represented thus:

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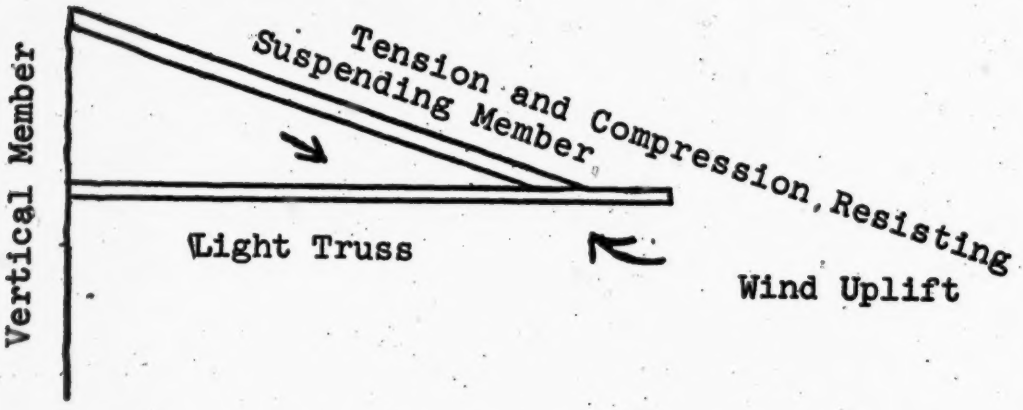
* F. followed by an arabic number designates a Finding of Fact by the Commissioner below. Such Findings of Fact are a part of the opinion of the Court of Claims and are printed in Appendix B, pages 10a-22a *infra*.



The dead weight of the truss as pulled down by gravity was gone. The truss was light. The resistance to wind uplift lay in the strong suspending member which held the truss down as well as up—a suspending member no longer capable of resisting only tension but *capable of resisting both tension and compression.* It was a totally different structure—no more reliance on dead weight and gravity and yet resistance to wind uplift provided by another element, i.e. a stout suspending member.

The difference between the '102 invention and prior art in respect of the forces utilized and the functions of the elements were tremendous. Consider for a moment:

Prior Art	*'102 Invention*
1. A heavy truss	1. A light truss
2. Resistance of wind uplift by deadweight and gravity	2. Resistance of wind uplift by the suspending member
3. A suspending member capable of taking tension only	3. A suspending member capable of taking compression and tension

It had never been done before (F. 13). It was novel (F. 12). It was commercially successful (F. 15). It was adopted as standard by the Navy (F. 15) which hired the co-inventor of the '102 patent to show the way, and infringing structures were built by the United States (F. 29, 32, 33, 34, 35) without any license from plaintiff (F. 5) and without paying plaintiff any compensation for the revolutionary, novel and economical concept (F. 30). There is no dispute as to these facts.

The Court of Claims invalidated the duly issued patent because it thought the invention—although for years every engineer had done just the opposite—was obvious. The fact that all previous attempts to achieve a novel cantilever design had relied on deadweight (gravity) to resist uplift—and there were a number of such attempts (F. 16, 17, 18, 21, 22, 23)—was deemed immaterial. The Court was impressed with the fact that all the forces were known and had been known for ages—that engineers knew wind uplift had to be resisted and knew all about the compression resistant qualities of various structural members (F. 22). So, although no engineer had been able to put all known elements and forces together to reach the novel '102 invention—although no engineer had previously had the concept, the Court of Claims bridged the mental gap, admitted that the '102 combination of the known elements into the hitherto unknown design was novel under §102 (F. 12) but held it obvious under §103 in the following laconic but totally unrevealing language (F. 27):

> "27. It is found after considering (a) the prior suspending cantilever aircraft hangar roofs and publications relating thereto described in finding 17; (b) the prior teachings of a cantilever member in other

load-carrying applications having a rigid suspending member capable of taking tension and compression as described in findings 19 and 20; (c) the published design of a suspended relatively shallow cantilever truss for use in an aircraft hangar described in finding 23; and (d) the calculations of Zackrison, described in finding 22, which reflect the practice of structural engineers, that it was *obvious* to one skilled in the art as of December 1952 to combine structural elements as recited in the asserted patent claims. Claims 1, 3 and 4 of the '102 patent are invalid under the provisions of 35 U. S. C. §103."

Paraphrased the Court's recital seems to mean that the Court "considered" (a) a French patent and publications about it, which admittedly relied on gravity and dead weight in the truss to resist wind uplift (F. 17); (b) a 40-year old bascule bridge patent (F. 19) and a 20-year old airplane patent (F. 20) in which it was thought that there were suspending members capable of resisting both tension and compression;* (c) a vague roof design which, when published, did not disclose whether the suspending member would take compression (F. 23); and (d) that one engineer, who ended up relying on deadweight and gravity to hold his truss in place, had analyzed the forces encountered in resisting wind uplift (F. 22)—and then the Court pronounced that such melange proved that the novel and undiscovered concept was obvious. The connection between the facts considered and the conclusion is not explained. It is just asserted. Not once did the Court speculate as to why, if the concept were really obvious, so many very

* As explained later, the Court misread these patents.

skilled engineers failed to see "the obvious". Not once did the Court wonder why, if the design were obvious, the Navy did not see it until, after the patent application, the Navy hired the co-inventor of the '102 patent to show it how.

Nor did the Court discuss any cases or explain any principles of law. The most relevant cases of *Graham* v. *John Deere Co., supra,* and *United States* v. *Adams, supra,* are not even cited. On this point, the only case mentioned (and not discussed) is *Martin-Marietta Corp.* v. *United States,* 373 F. 2d 972, 153 USPQ 206 (1967) and then only to list the three "preliminary factual inquiries" first announced in the *John Deere* case as important (see, *infra* p. 6a). The proper scope of such inquiries and the approved application of conclusions therefrom are not revealed unless F. 27 quoted in full above may be called such a revelation.

Reasons for Granting the Writ

1. Until the case of *Graham* v. *John Deere Co., supra,* the tests used to determine "non-obviousness" under §103 had been *objective* tests devised by the Courts of Appeals.

> *Reiner* v. *I. Leon Co.,* 285 F. 2d 501, 504 (2nd—1960), cert. den. 366 U. S. 929 (1961);
> *Kaakinen* v. *Peelers Co.,* 301 F. 2d 170, 172-3 (9th—1962), cert. den. 371 U. S. 823;
> *Copease Mfg. Co.* v. *American Photocopy Equipment Co.,* 298 F. 2d 772, 781-82 (7th—1961);
> *Honolulu Oil Corp.* v. *Shelby Poultry Co.,* 293 F. 2d 127, 130-32 (4th—1961).

One of such cases had been twice denied review by this Court. *Holley* v. *Outboard Marine Corporation,* 241 F.

Supp. 657 (N. D. Ill.—1964), aff'd 345 F. 2d 351, cert. den. 383 U. S. 934, reh. den. 384 U. S. 914. There was much to commend such objective tests as the legal standard. Robbins—*Subtests of "Nonobviousness": A Nontechnical Approach to Patent Validity,* 112 Univ. Pa. L. Rev. 1169 (1964).

But in the *John Deere* case, this Court, although admitting these objective tests were "more susceptible of judicial treatment than are the highly technical facts often present in patent litigation", swept the objective tests into "secondary considerations"—to be used only "to guard against slipping into use of hindsight" and "to resist the temptation to read into prior art the teachings of the invention in issue." *Graham* v. *John Deere Co., supra,* 35-36, 17.

In the *John Deere* case, the subjective test was relatively easy to apply. The invention involved was a plough and other similar ploughs had been previously patented. The variations between the prior patented ploughs and the *Deere* plough were minor. The same elements performed the same functions and the same results were obtained. The variation was really a change in the arrangement of previously patented elements. There were no forces eliminated like the elimination of dead weight and gravity in the '102 patent.

And even then this Court admitted that its *John Deere* rule was not too precise and would need clarification (p. 18):—

> "This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual

> context. The difficulties, however, * * * should be amenable to a case-by-case development."

The instant case and Finding 27 are more concealing than revealing—of reasoning and thought.

So far the only clarification has come in *United States* v. *Adams, supra.* The Court below has offered no explanations. The "helping hands" of the secondary considerations pass unnoticed. The cited case of *Martin-Marietta Corp.* v. *United States, supra,* involving the interchange in airplane gasoline tanks of two substances both well known to have the same resistant properties toward aromatic fuels, is neither relevant nor helpful.

And, if *United States* v. *Adams, supra,* does not require a reversal of the Court below, *United States* v. *Adams* requires further detailed explanation by this Court.

In the *Adams* case, the United States used without license or compensation—much as it did the '102 invention—a patented wet cell battery which relied on tap water instead of a chemical solution as the electrolyte. The invention lay in the substitution of tap water for the usual acid bath. The United States, as in this case, attempted to justify taking the invention by claiming that, although novel, it was obvious and, therefore, could not be protected by a patent. True—wet cell batteries were old hat. Everyone knowing anything about electricity knew about the use of two metal poles (electrodes) in a liquid bath (the electrolyte) to generate electric current. The properties of almost every metal had been catalogued. Magnesium and cuprous chloride as used by Adams had been used before. All sorts of baths had been used. Only no one had thought of using ordinary water—until Adams. And this Court

held that the use of water—although simple and everywhere in good supply—was not obvious. And the proof positive was that no one had done it before.

In the face of the *Adams* case, there is a decidedly forced flavor to the Court of Claims' reliance below (F. 27, *infra* p. 19a) on a French patent which hardly came close, on an obscure 40-year old bascule bridge patent, on the assumed forces encountered during the upside down flying of a 20 year old airplane patent (there was no evidence it was ever built), on a line drawing which did not reveal the resistance offered to wind up lift, and on the calculations of a very skilled engineer who reached a conclusion opposite to the '102 invention. Clearly this is an unrelated conglomeration upon which to base an argument that something seen by no one—a concept conceived by no one—was, nevertheless, obvious. With all deference, the lack of revealing explanation in F. 27, the sharp contrast between the previous findings and the conclusion in F. 27 and the absence of demonstrated connection between that conclusion and the considerations recited makes one wonder what really caused the Court below suddenly to assert "obvious". Until F. 27 the findings all point in the opposite direction. Yet except for F. 27—and some repetition thereof in narrative form in the opinion of the Commissioner (*infra*, pp. 6a-10a) with more emphasis on the calculations of skilled engineers which led nowhere—there is nothing by way of explanation.

If this Court really expected subsequent cases to produce uniformity of thought in applying the *John Deere* rule (p. 18), the decision and opinion below is most disappointing. It explains nothing and its conclusion is not reached by any visible reasoning.

Yet to have some uniformity and stability in testing patents under 35 U. S. C. §103 is most important. Without such stability and uniformity, investors will not know whether they have enforceable rights or a mess of pottage. Poorer patentees will be discouraged from asserting valid patent rights. Financially powerful operators (and the United States is the most powerful and quite predatory in this field) will be helped to force unsatisfactory and undesirable settlements. Confidence in the patent system could be adversely affected.

This case offers this Court a real opportunity to move forward on the path only pointed at by the *John Deere* and *Adams* cases.

2. There is only one difference between the instant case and the *Adams* case—other than the absolutely opposite results reached by the Courts. The sole difference between the cases is that, in the *Adams* case, the substitution of tap water as the electrolyte was first said by the United States to be unworkable. Whether that was the expression of a sincere belief on the part of the Government representatives or merely smoke screen to hide an intended appropriation does not appear. In the instant case, there is no evidence as to what any engineering expert—Government representative or otherwise—said or thought when he first became aware of the '102 invention. The structural engineering trade was enthusiastic and regarded the '102 invention as ingenious, novel, unique and economical (PX 8, pp. 3-6, 11; PX 14, p. 11; PX 6; PX 7; Tr. 8-20, 90-92, 118, 119, 787, 790; F. 15; *infra* p. 14a).* As a matter

* PX designates a plaintiff's exhibit below and Tr. the page of the typewritten transcript of evidence.

of fact, although there is nothing in the evidence on the subject, common sense dictates that the most likely reaction to revelation of the '102 invention was "Why didn't I think of that".

But otherwise the substances of the cases are identical. Both wet batteries and cantilevers had been studied from every angle. The functions and forces were well known in the respective trades. Prior art had come close—the levels of skill were such that people should have thought of the answer. Yet in both cases prior teachings pointed away from the concept of the invention. Water was thought to be an unacceptable electrolyte for wet batteries —until Adams. In structural engineering, gravity and dead weight were thought to be the forces to resist wind uplift (F. 13, p. 14a). No one before Erwin and Rongved (plaintiff's assignors) thought of overcoming wind uplift in a cantilevered structure not by deadweight in the truss but by strength (resistance to compression and tension) in the suspending member. There is reprinted in Appendix C, pages 24a-33a some very interesting testimony (Tr. 1141-1151) in which Professor Fox, plaintiff's expert explained why, prior to the '102 invention, he would have followed the prior practice.

Clearly the rule of the *Adams* case is that the concept is vital and that the simplicity thereof—or obviousness of the mechanics AFTER the concept has struck—is immaterial. It is the situation BEFORE and not afterward which counts. And on that point there is nothing more persuasive than that BEFORE the '102 invention was announced no one thought of it although many had been working (without *conceiving* of the '102 *concept*) for years in trying to make cantilevered structures more economical to build and ex-

pand (F. 17, F. 21, F. 22, F. 23; Tr. 752-753; 960-963; DX *24, DX 31, DX 32, DX 34, PX 34).

This Court is urged to insist on a return to realism. "Obviousness" must be found in what men did when they tried and not by Monday morning guessing as to what they might have done—or even should have done—but did not. The winning football play is always obvious on Monday. That is the proper rule of the *Adams* case and, there being no difference between the cases and, since the Court of Claims was clearly influenced by hindsight and explained nothing, this is the time for this Court to make the rule clear.

3. In its hindsight efforts to find "obviousness" where no one else found it, the Court below went far afield to find a hint of prior teaching with respect to suspending members which resisted tension and compression. The instances were so old and so unrelated to airplane hangars that they would not have been taken seriously if the Court below had not elevated them by acceptance. There is no evidence that they were ever considered by structural engineers. They involved not only non-analogous arts but they were also so unanalyzed and so avidly seized upon that they were misinterpreted. Thus is illustrated a danger of imprecise analysis of the standards of the *John Deere* and *Adams* cases.

First, in an effort to prove that something unseen was obvious the Court below turned to a 20-year old low wing McDonnell airplane patent (U. S. No. 1862902, see the pertinent drawing and part thereof, *infra,* pp. 23a-24a) and

* DX designates defendant's exhibit below.

then fastened on a most remote specification of that patent (*infra,* p. 24a). The very remoteness of the pertinent provision of this patent should have preached caution to the Court below. In this 20 year old patent of a low wing airplane devoted mostly to novel designs for air foils, ailerons, flaps and automatic air slots, it was noticed by the Government expert that the low wing had slanting struts (strut 90) connecting the wings to the fuselage (*infra,* p. 23a). Reasoning in reverse from some literature about *high wing* mono planes (Tr. 318-20), for the witness knew nothing about aerodynamics (Tr. 493), the witness concluded that the slanting struts on the low wing plane would take tension and compression—and, therefore, should have made obvious the '102 invention. The statement in the patent, although not mentioned by the witness or the Commissioner, is to the contrary (see italics *infra,* p. 24a).

On its face, the reasoning is highly artificial and refuted by the facts. For 20 long years (and in fact until discovered below) the supposed revelation of the McDonnell patent remained unnoticed. No one in the structural engineering field appreciated it or saw its alleged significance. Yet as the Court below frankly stated, unless the '102 concept can be found in the McDonnell wing, it cannot be found anywhere prior to the '102 invention (F. 13, F. 16).

Can one really say that the *John Deere* and *Adams* cases makes "obviousness" a game—and that what might have been discovered after a meticulous search can be called "obvious" even though it existed buried deep in the archives and was never found. To state the proposition is to deny it.

Second, plaintiff insisted below and still insists that airplane wing design is not an art analogous to hangar and

structural design and should, therefore, never have been considered. In response, the Commissioner and the Court below merely asserted the contrary without trying to explain why. Here again are involved important principles of law, which require clarification and statement by this Court.

There is no analogy between airplane wings and hangar roofs. To be analogous, the elements *and* purposes of the two arts must be the same. *Stearns* v. *Tinker & Rasor,* 220 F. 2d 49 (9th—1955), cert. den. 350 U. S. 830; *Mott Corporation* v. *Sunflower Industries Inc.,* 314 F. 2d 872 (10th—1963); *A. J. Deer Co. Inc.* v. *U. S. Slicing Mach. Co.,* 21 F. 2d 812 (7th—1927); *Radiator Specialty Co.* v. *Buhot,* 39 F. 2d 373 (3rd—1930). This was ignored without justification or discussion below.

Third, it is unrealistic to assume that a structural engineer would run through nine pages of text and 756 lines of an old low wing airplane patent to find a reference to the resistant capabilities of a strut or would search out a Pilot's Manual (DX26) dealing with another type (high wing) plane and apply its teaching to a figure in the patent. The law as to "obviousness" must make a slight bow in the direction of Common Sense and Realism.

Fourth, and if the McDonnell patent had really been analyzed—the Court below relied on erroneous expert testimony—, it would have been discovered that the strut in question was never in tension. The erring expert had assumed that on landing strut 90 would be in tension (Tr. 319-20) on the theory that the low wings would be "hanging down". But he forgot about the landing gear—on landing the strut would continue in compression—the

patent itself makes that clear. (DX 5, Fig. 2 and p. 6, lines 116 et seq., see *infra,* pp. 23a-24a) Contrary to the Court below, this strut 90 would never be in tension and, therefore, even if airplane wings are analogous to hangar roofs—as they are not—would not have even hinted at the '102 invention. The Court below was both overeager and wrong—a sad testimonial to the misapplication of the *John Deere* and *Adams* case rules.

The full facts with respect to this erroneous conclusion about the McDonnell struts, which conclusion really shapes the key finding below (F. 27), were not argued or discussed before the Commissioner. Plaintiff concentrated its argument before the Commissioner on the non-analogy between airplane wings and stationary structures. No one mentioned the flat statement in the McDonnell patent (*infra,* p. 24a) contradicting both the Commissioner and the erroneous expert, until plaintiff's brief before the Court of Claims. Defendant's only effort to avoid the error was to argue that maybe the stresses on the pertinent strut would shift from compression to tension after the plane had come to rest on the ground. This would be contrary to common sense and the laws of physics. For some reason, the Court of Claims passed over this point without any discussion. Yet the point was most important and failure to discuss such points highlights the danger to our patent system if the rule of the *John Deere* case is not further clarified by this Court.

In addition to the McDonnell patent, the Commissioner, and in turn the Court of Claims, placed some reliance (the amount is not clear) on a 40 year old bascule bridge (Strauss—PATENT No. 974358) patent. Testimony that bas-

cule bridges were not analogous to airplane hangars (Tr. 885) was ignored. Admittedly, it was said in the bridge patent that (F. 19):

> "A rigid link connects the moving truss with its counter weight. This link is disclosed to act as a tension member * * * and subsequently as a compression member."

This would seem to win the game—tension and compression in the same member, irrespective of analogy. Of course, this statement was never noted by structural engineers but if patents are a game under 35 U. S. C. §103, why worry?

Again, however, there was a misinterpretation of the bascule bridge patent in its relation to the '102 invention as later made clear in the patent itself

> "The link 9 acts as a tension member during a part of the movement, and then as a compression member, and hence this construction permits the complete opening of the span."

In other words as was made clear, this rigid link 9 was not a suspending member (Tr. 894) but rather a movable *balancing link* between the counter weight and the movable leaf of the bascule bridge (DX 1, p. 2 left col. 2, lines 21-22, Tr. 892, 894, 1064-66). The point is not merely to find some element which takes compression and tension—the relevant point would have been to find—in an analogous art—a suspending member or something acting as a suspending member which resists wind uplift by compression and resists gravity by tension. And that is clearly not present in the Strauss patent.

These erroneous interpretations may be forgiven the Commissioner. The proper meaning of the airplane wing and bascule bridge patents were not argued before him—it was thought and argued that the arts were not analogous and that such would dispose of the point. It is regretted that the Commissioner never discussed the rules of "analogous arts" and error as to the proper interpretation of the patents can perhaps be forgiven—although the error emphasizes the need for caution when full argument is not presented.

But both points were argued before the Court of Claims and ignored. The intervention of this Court in this important patent rule is vital.

Conclusion

In the *John Deere* and *Adams* cases, this Court announced a new and serious standard for interpreting "obvious" under 35 U. S. C. §103. The standard was a subjective one which admittedly required further delineation by a case-by-case development. The rule—affecting stability and uniformity in patents—was admittedly important. Such case-by-case development by this Court in meticulous detail is equally important.

This case is an apt vehicle for the interpretation of this essential patent ingredient. The decision below is unrealistic; it discusses and analyzes none of the *John Deere* or *Adams* rules. Its eagerness to make "obviousness" a semantic exercise instead of a real factual inquiry has led the Court below into remote patent by-roads and error.

Granting of this petition will afford this Court an opportunity to round out and set straight the meaning of 35 U. S. C. §103 and the standards of the *John Deere* and *Adams* cases.

July 17, 1968.

Respectfully submitted,

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